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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/665,669	09/20/2000	Thomas G. Woolston	99892	5562

7590 06/26/2002
John C Phillips
116 South Patrick Street
Alexandria, VA 22314

EXAMINER

SAGER, MARK ALAN

ART UNIT	PAPER NUMBER
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3714

DATE MAILED: 06/26/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/665,669

Applicant(s)
Woolston

Examiner
Sager

Art Unit
3714



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Sep 20, 2000 and Jan 3, 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-93 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20-93 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120


- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 3, 4
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:


MARK SAGER
PRIMARY EXAMINER

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 20-93 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-35 of U.S. Patent No. 6162123. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to claim the method or apparatus broader in order to obtain the most commercially viable form of invention or in order to obtain the broadest protection for invention for securing commercial viability. Essentially, the omitted language limited the invention and thus by omitting the language, a broader form of invention is claimed which secures broader

protection for commercial viability. Additionally, connecting game players together in a computer network to play is obvious for permitting remote play.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 70, 80 and 82-83 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The recited means does not appear in combination with another recited element of means, is subject to an undue breadth rejection under 35 U.S.C. 112, first paragraph. In re Hyatt, 708 F.2d 712, 714-715, 218 USPQ 195, 197 (Fed. Cir. 1983) (A single means claim which covered every conceivable means for achieving the stated purpose was held non-enabling for the scope of the claim because the specification disclosed at most only those means known to the inventor.). When claims depend on a recited property, a fact situation comparable to Hyatt is possible, where the claim covers every conceivable structure (means) for achieving the stated property (result) while the specification discloses at most only those known to the inventor. In this instance, the claims recite a step which does not appear in combination with another step and thus, similarly to situation comparable to Hyatt, the claim covers every conceivable step for achieving the stated process while the specification discloses at most only those known to the inventor.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 20-26, 29, 31-34, 36-43, 45, 47, 50-62, 64, 66, 68, 70-72, 74, 77-86, 88 and 91-93 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Meredith.

7. Claims 70, 77-84 and 91-93 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by O'Berrigan (5823845).

8. Claims 20-21, 23, 25-26, 29, 31-38, 50-51, 54-56, 59-60, 68, 70, and 77-79 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Sato (5453758).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35

U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. Claims 27-28, 30 and 69 are rejected under 35 U.S.C. 103(a) as being unpatentable over either Sato (5453758) or Meredith (5542672) each in view of either Eisenbrey (5516105) or Casio (JP 06-301474) or Rosenberg (6028593). Sato and Meredith each discloses a game controller comprising claimed steps/features (supra). Meredith discusses in background that controllers for firing a gun or throwing a punch which are shaped as guns, rifles or boxing gloves are known. Further, Meredith's controller is equivalent to claimed method or apparatus for providing haptic or tactile feedback from a gyroscope in accordance with game state; whereas, Sato's controller is equivalent to claimed method or apparatus for providing positional input for visual sensory sensation output. Alternatively, Eisenbrey (3:34-37) or Casio (abstract, figs. 1, 4, 8-9) or Rosenberg (6:30-67) each disclose systems or apparatus using an instrument for a weapon in an electronic game such as a sword or saber for interaction such as sword play simulation in fencing, swashbuckling, pirate or medieval themes. Therefore, it would have been obvious to a routineer at a time prior to the invention to add weapon, sword, saber as known or as taught by Eisenbrey or Casio or Rosenberg to Meredith's or Sato's controller for sword play simulations in fencing, swashbuckling, pirate or medieval themes.

12. Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Meredith (5542672) in view of Sato (5453758). Meredith discloses a controller equivalent to claimed invention. Alternatively, Sato discloses a controller teaching use of infrared transceivers as an equivalent sensor. Therefore, it would have been obvious to an artisan at a time prior to the invention to add infrared transceivers as known or taught by Sato to Meredith's controller for sensing relative position of controller.

13. Claim 49 is rejected under 35 U.S.C. 103(a) as being unpatentable over either Sato (5453758) or Meredith (5542672). Sato and Meredith each disclose apparatus or methods comprising claimed features (supra) except a plurality of game components networked together for enabling communication among the plurality of game components. However, networked gaming for a plurality of game components networked together for enabling communication among the plurality of game components is notoriously well known such as exemplified by DARPA's SIMNET for connecting remote units (users/players) in a virtual environment for simultaneous competition. Therefore, it would have been obvious to a routineer at a time prior to the invention to add 'plurality of game components' and a 'network for enabling communication among the plurality of game components' as notoriously well known such as by SIMNET to either Sato or Meredith's apparatus or method to permit remote participation in a virtual environment for multi-player competition.

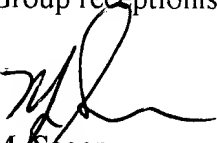
Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. A. Sager whose telephone number is (703) 308-0785. The examiner can normally be reached on T-F from 0700 to 1700. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Valencia Martin Wallace, can be reached on

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(703) 308-4119. The fax phone number for this Group is (703) 872-9302. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1148.



M. Sager
Primary Examiner
June 23, 2002